

REMARKS

A. 35 U.S.C. § 102

1. Claims 1, 2, 4, 5, 7 and 8

In the Office Action of September 22, 2004, claims 1, 2, 4, 5, 7 and 8 were rejected under 35 U.S.C. § 102(b) as being anticipated by Slater. Applicant traverses this rejection because claim 1 recites a planar area that moves parallel to a first direction and below a web of a substrate, wherein “said web moves substantially independently of said planar area and said web lies upon said planar area” (emphasis added). The Office Action asserts that the web 52 corresponds to the web recited in claim 1. However, claim 1 further recites “an applicator that places a label upon a portion of said web that lies above said planar area” (emphasis added). Slater’s web 52 already has labels as shown in FIG. 1. Nowhere during Slater’s process are labels added or placed upon the web 52. The Office Action asserts that the outfeed conveyor 35 corresponds to the claimed applicator. However, there is no outfeed conveyor 35. If the Office Action meant outfeed conveyor 32, then the rejection is still flawed in that the conveyor does not place a label upon the web 52. Instead, the web 52 moves around a peel plate 54 and delivers a label onto a form 40 that is supported on conveyor 32. (Col. 4, ll. 37-38). So, web 52 of Slater functions differently than claim 1’s web in that it places a label on an object instead of having a labeled placed on itself. Accordingly, Slater’s web 52 does not anticipate the web of claim 1.

Note that form 40 and conveyor 32 also do not anticipate the web and planar area, respectively, recited in claim 1 in that while form 40 lies upon conveyor 32 its movement is dependent on the movement of the conveyor 32. As recited in claim 1, “said web moves substantially independently of said planar area” (emphasis added). Accordingly, claim 1 is not

anticipated by Slater and so the rejection is improper and should be withdrawn.

Besides not being anticipated by Slater, claim 1 is not rendered obvious by Slater since there is no motivation to either 1) add labels to Slater's web 52 or 2) have form 40 move substantially independently of the conveyer 32.

2. Claims 3 and 6

Claims 3 and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by Slater. Applicant traverses this rejection because claim 3 recites a planar area that moves parallel to a first direction and below a web of a substrate, wherein "said web moves substantially independently of said planar area" (emphasis added). Claim 3 further recites "an applicator that places a label upon a portion of said web that lies above said planar area" (emphasis added). As pointed out in Section A.1, Slater's web 52 does not anticipate the web recited in claim 3 since it already contains labels.

As pointed out in Section A.1, form 40 and conveyer 32 also do not anticipate the web and planar area, respectively, recited in claim 3 in that while form 40 lies upon conveyer 32 its movement is dependent on the movement of the conveyer 32. Furthermore, claim 3 recites that a moving conveyer defines the planar area and form 40 certainly is not a moving conveyer belt. Accordingly, claim 3 is not anticipated by Slater and so the rejection is improper and should be withdrawn.

Besides not being anticipated by Slater, claim 3 is not rendered obvious by Slater since there is no motivation to either 1) add labels to Slater's web 52 or 2) have form 40 move substantially independently of the conveyer 32 and be a moving conveyer belt.

3. Claims 34, 35 and 37

Claims 34, 35 and 37 were rejected under 35 U.S.C. § 102(b) as being anticipated by Slater. Applicant traverses this rejection. Claim 34 recites a process that includes moving a planar area parallel to a first direction and below a web of a substrate, wherein “said web lies upon said planar area and said moving of said web is performed substantially independently of said moving said planar area” (emphasis added). Claim 34’s process further includes “placing a label upon a portion of said web that lies above said planar area.” For reasons similar to those pointed out in Section A.1, Slater’s web 52 is not influenced by a process that anticipates the claimed process acting on the web recited in claim 34 since it already contains labels and does not have labels placed on itself. Form 40 and conveyor 32 also do not anticipate the claimed process that involve the web and planar area, respectively, recited in claim 34 in that while form 40 lays upon conveyor 32 its movement is dependent on the movement of the conveyor 32. Accordingly, claim 34 is not anticipated by Slater and so the rejection is improper and should be withdrawn.

Further evidence that the rejection is improper is that claim 34 has been rejected as being obvious under 35 U.S.C. § 103 in view of Slater and Barber et al. If Slater truly anticipated claim 34 then a rejection under Section 103 would not be proper.

Besides not being anticipated by Slater, claim 34 is not rendered obvious by Slater since there is no motivation to either 1) add labels to Slater’s web 52 or 2) have form 40 move substantially independently of the conveyor 32.

B. 35 U.S.C. § 103

1. Slater and Chamberlain et al.

a. Claims 9-15

Claims 9-15 were rejected under 35 U.S.C § 103 as being obvious in view of Slater and Chamberlain et al. Claims 9-15 depend directly or indirectly on claim 1. Chamberlain et al. does not solve the deficiencies of Slater in that Chamberlain et al. does not suggest altering Slater so that either 1) labels are added to Slater's web 52 or 2) form 40 moves substantially independently of the conveyer 32. Without such suggestion, the rejection is improper and should be withdrawn.

b. Claim 39

Claim 39 was rejected under 35 U.S.C § 103 as being obvious in view of Slater and Chamberlain et al. Claim 39 depends directly on claim 34. Chamberlain et al. does not solve the deficiencies of Slater in that Chamberlain et al. does not suggest altering Slater so that either 1) labels are added to Slater's web 52 or 2) form 40 moves substantially independently of the conveyer 32. Without such suggestion, the rejection is improper and should be withdrawn.

2. Slater and Barber et al.

a. Claims 16-21

Claims 16-21 were rejected under 35 U.S.C § 103 as being obvious in view of Slater and Barber et al. Claims 16-21 depend directly or indirectly on claim 1. Barber et al. does not solve the deficiencies of Slater in that Barber et al. does not suggest altering Slater so that either 1) labels are added to Slater's web 52 or 2) form 40 moves substantially independently of the conveyer 32. Without such suggestion, the rejection is improper and should be withdrawn.

b. Claims 34, 42 and 51

Claims 34, 42 and 51 were rejected under 35 U.S.C § 103 as being obvious in view of Slater and Barber et al. As pointed out above in Section A.3, Slater fails to disclose or suggest either 1) adding labels to Slater's web 52 or 2) having form 40 move substantially independently of the conveyer 32. Barber et al. does not solve the deficiencies of Slater in that Barber et al. does not suggest either 1) adding labels to Slater's web 52 or 2) having form 40 move substantially independently of the conveyer 32. Without such suggestion, the rejection is improper and should be withdrawn.

C. Claims 22-32, 36, 38, 40, 41 and 45-51

Applicant notes with appreciation that claims 22-32, 36, 38, 40, 41 and 45-51 have been indicated to contain allowable subject matter. Claims 22, 36, 40 and 45 are being amended in independent form. Accordingly, claims 22-32, 36, 38, 40, 41 and 45-51 should be allowed.

As mentioned above claims 22, 36, 40 and 45 have been amended to be in independent form. Since the amendments incorporate subject matter that is inherently present in the claims, the amendments are not being made for reasons related to patentability. *See, Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 535 U.S. 722 (2002).

D. Claims 33, 43, 44, 52 and 56-65

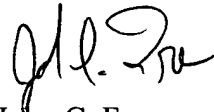
Applicant notes with appreciation that claims 33, 43, 44, 52 and 56-65 have been allowed.

CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 1-52 and 56-65 are in condition for allowance and seek an early allowance thereof. If for

any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J.C. Freeman", written in a cursive style.

John C. Freeman
Registration No. 34,483
Attorney for Applicant

BRINKS HOFER
GILSON & LIONE
P.O. Box 10395
Chicago, Illinois 60610
(312) 321-4200

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